

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**I. DISPOSITION OF THE CLAIMS**

Claims 8, 10-12, and 14 - 17 are requested to be cancelled.

Claims 1, 9, and 13 are currently being amended. No new matter has been added.

After amending the claims as set forth above, claims 1-7, 9, 13, and 18-21 are now pending in this application.

**II. INFORMATION DISCLOSURE STATEMENT**

The Office indicated that the Information Disclosure Statement (IDS) filed May 25, 2006, was not considered because cited references were not submitted. Office Action, page 2, paragraph 4. Applicants note that the cited references were originally cited in the International Search Report and, thus, need not have been submitted to the Office.

To further prosecution, however, Applicants have filed concurrently herewith an IDS submitting the references cited in but omitted from the IDS filed May 25, 2006. Applicants respectfully request that each listed document be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

**III. ALLOWABLE SUBJECT MATTER**

Applicants thank the Office for indicating that claims 1-7 and 19-21 are allowed. Office Action, page 3, paragraph 6.

**IV. INDEFINITENESS REJECTION**

Claims 9 and 13 stand rejected as indefinite under 35 U.S.C. § 112, second paragraph. The Office considers claim 1 to be closed-ended with respect to the positions on the HLA-A gene, because these are recited using “consisting of” language. Claim 1 stated “the set of positions consists of positions 98, 414, 539, 282, 571, 368, 256, 292, 238 and 270”. The

Office asserts that claims 9 and 13 (which depend from claim 1) improperly refer to positions other than those recited in claim 1.

Applicants have obviated this ground of rejection by amendment. First, claim 1 has been amended to recite “the set of positions consists essentially of positions 98, 414, 539, 282, 571, 368, 256, 292, 238 and 270”. Second, claims 9 and 13 have been amended to recite “generating HLA-A subgroups A\_O using the method of claim 1” and to recite “further analyzing positions...” (referring to additional positions).

The “further analyzing” step is separately recited to obviate any issue of whether the initial set of recited positions is closed or open-ended.

Moreover, the recitation “consists essentially of” allows for additional positions beyond those recited in claim 1, because the additional positions recited in claims 9 and 13 do not materially affect the basic and novel characteristics of the claimed invention.

The Manual of Patent Examining Procedure (MPEP) instructs examiners as follows (M.P.E.P. § 2111.03):

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

Here, this standard is satisfied for the invention claimed in claim 1. Moreover, the MPEP notes that where a claim contains both “comprising” and “consists of” language, certain aspects of the claim remain open-ended (see M.P.E.P. § 2111.03, discussing similar facts):

When the phrase “consists of” appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004) (The claims at issue “related to purified DNA molecules having promoter

activity for the human involucrin gene (hINV).” *Id.*, 73 USPQ2d at 1365. In determining the scope of applicant's claims directed to “a purified oligonucleotide comprising at least a portion of the nucleotide sequence of SEQ ID NO:1 wherein said portion consists of the nucleotide sequence from . to 2473 of SEQ ID NO:1, and wherein said portion of the nucleotide sequence of SEQ ID NO:1 has promoter activity,” the court stated that the use of “consists” in the body of the claims did not limit the open-ended “comprising” language in the claims.

“The test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).” See M.P.E.P. § 2173.02.

Here, a person of ordinary skill in the art could readily discern the metes and bounds of the claims as amended. For all the reasons presented above, Applicants respectfully request that this ground of rejection be withdrawn.

### **CONCLUSION**

Applicants believe that the present application is now in condition for search and examination of all pending claims. Favorable reconsideration of the restriction requirement for the claims as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 16-FEB-2010

By 

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